RESPONSE UNDER 37 CFR 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2837

PATENT APPLICATION
Docket No.: 5038-293

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Andrew T. Wilson
Serial No.:	10/684,167
Examiner:	Jeffrey Donels
Filed:	October 10, 2003
Group Art Unit:	2837
Confirmation No.:	2311
For:	PORTABLE HAND-HELD MUSIC SYNTHESIZER AND NETWORKING METHOD AND APPARATUS

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal.

This review is requested for the reasons stated on the attached sheets. (Note: no more than five (5) pages may be provided.)

I am the:

- ☐ applicant/inventor
- ☐ assignee of record of the entire interest
  See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed)
- ☒ attorney or agent of record
- ☐ attorney or agent acting under 37 CFR 1.34

Total of (1) forms is submitted.

Customer No. 20575

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

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P12515X

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ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

This case is appropriate for Panel Review under the Pre-Appeal Brief Conference Program because of omission of essential elements required to establish a *prima facie* case of obviousness. Claims 11-16 and 27-30 are being appealed.

Specifically, claim 27 recites *plural portable musical apparatus in physically separated proximity with each other and capable of two-way communication therebetween of an audio score over said wireless network, each musical apparatus including:... an audio score mixing mechanism*. Claim 11 includes similar limitations. In the final office action, claims 27 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ito, U.S. Patent Publication No. 2003/0121401 (hereinafter "Ito") in view of Sitrick, U.S. Patent No. 6,084,168 (hereinafter "Sitrick"). The Ito reference discloses a system in which only one apparatus on the network has a mixer. The Examiner appears to acknowledge, while

rejecting claims 11-16, 21-24, and 27-31 in the final office action, that Ito/Sitrick combination does not teach the limitation. The Examiner, however, alleges that it would have been obvious to adapt the Ito/Sitrick combination so that each device would have a mixing mechanism, as it has been held that mere duplication of working parts does not constitute nonobviousness and refers to MPEP 2144.04. The Examiner has essentially extracted a "*per se*" rule of obviousness from *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), which is referred to in the relevant section of MPEP 2144.04.

However, The Court Of Appeals For The Federal Circuit has held that the precedents do not establish any *per se* rules of obviousness, and that reliance on *per se* rules of obviousness is legally incorrect and must cease. *In re Ochiai*, 37 USPQ2d 1127, 1133 (CAFC 1995). Instead, section 103 requires a fact-intensive comparison of the claimed invention with the teachings of the prior art. In the present application, the prior art provides no suggestion or motivation to include a mixing mechanism in a plurality of operatively coupled musical apparatus. Thus, claims 11 and 27 is patentable over the Ito/Sitrick combination. Moreover, the limitation makes possible novel and nonobvious features having advantages over the prior art, some of which are discussed in the specification at page 7, lines 10-12. The Examiner has not identified analogous features in the prior art. Therefore, examiner has not made out a *prima facie* case of obviousness under 35 USC 103(a) for claims 11 and 27.

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